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09/650,849	08/29/2000	Alicia Anne Chastain	RSW9-2000-0065US1	9889

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EXAMINER

JOHNSON, MARLON B

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/01/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/650,849

Applicant(s)

CHASTAIN ET AL.

Examiner

Marlon Johnson

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections – 35 U.S.C. 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-19, and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millier et al. (5,899,995), and further in view of Elson (6,216,122).

In considering claims 1, 16, and 26,

Millier et al. discloses a method, a data processing system, and a computer program product in a computer readable medium for modifying rules to process electronic messages:

determining whether the electronic message matches the rule (see col. 3, lines 26-34; col. 10, lines 30-42);

identifying characteristics of the electronic message if a match between the rule and the electronic message is absent (see col. 6, lines 38-67; col. 10, lines 30-42); and

modifying the rule using the characteristics to form a modified rule (see col. 7, lines 26-41; col. 10, lines 30-42).

Although Millier shows substantial features of the claimed invention, he fails to disclose detecting user input moving an electronic message into a folder. However, prior art, as admitted in the background of Elson, whose invention is an e-mail search engine, discloses such a detection of a user input moving an electronic message into a folder (see col. 2, lines 10-23; Fig.

1). Therefore, given the teachings of the prior art disclosed in Elson, it would have been obvious for a person having ordinary skills in the art to modify Millier et al. by detecting user input moving an electronic message into a folder in order to provide both manual and automatic actions of the message.

In considering claims 8, 23, and 27,

Millier et al. discloses a method, a data processing system, and a computer product product in a computer readable medium for modifying rules for processing messages, comprising the steps of:

determining whether the electronic message matches the rule (see col. 10, lines 30-42);

identifying characteristics of the electronic message if a match between the rule and the electronic message is absent (see col. 10, lines 30-42; Fig. 8, Steps S81-, S820, S825); and

modifying the rule using the characteristics (see col. 10, lines 30-42; Fig. 8, Steps S81-, S820, S825).

Additionally,

The prior art admitted by Elson discloses detecting a manipulation of an electronic message, wherein a rule is associated with the manipulation (see col. 2, lines 10-23; Fig. 1);

In considering claims 2 and 17,

Millier et al. discloses a method and data processing system further comprising:

processing received messages using the modified rule (see col. 10, lines 30-42; Fig. 8, Steps S81-, S820, S825).

In considering claims 3 and 18,

Millier et al. discloses a method and data processing system wherein the processing step is initiated in response to another user input approving use of the modified rule (information evaluator) (see col. 10, lines 30-42; Fig. 8, Steps S81-, S820, S825).

In considering claims 4 and 19,

Elson discloses a method and data processing system wherein the criteria includes priority-based common fields and common content (see col. 3, lines 27-45).

In considering claims 6 and 21,

Elson discloses a method and data processing system wherein at least one of a sender address, a selected word in a subject line body of the electronic message, a select word in a body of the electronic message, and an attribute of the time/date field of the electronic message (see col. 3, lines 27-45).

In considering claims 7 and 22,

Millier et al. discloses a method and data processing system wherein the identifying step includes: identifying the characteristics of the electronic message absent from the rule (see col. 10, lines 30-42; Fig. 8, Steps S81-, S820, S825).

In considering claims 9 and 24,

Although Millier et al. and Elson show substantial features of the claimed invention, they fail to disclose the manipulation being a deletion of the electronic message. Nonetheless, deleting electronic messages are commonly used for mail applications and would have been an obvious modification to the system disclosed by Millier et al. and Elson. It would have been obvious for a person having ordinary skills in the art to modify Millier et al. and Elson by having the action

Art Unit: 2153

being a deletion of the electronic message in order to provide an action for the complete removal of a message from the system.

In considering claims 10 and 25,

The prior art of Elson discloses a method and data processing system wherein the manipulation is a movement of the electronic message from a first folder (mail filter) to a second folder (inbox) (see col. 2, lines 10-23; Fig. 1).

In considering claim 11,

Millier et al. discloses a data processing system comprising:

a bus system (see col. 5, lines 14-29; Fig. 1, Host Bus 20, Memory 30);

a communications unit connected to the bus system (see col. 5, lines 14-29; Fig. 1, Communication Controller 70);

a memory connected to the bus system, wherein the memory includes a set of instructions (see col. 5, lines 14-29; Fig. 1, Memory 30); and

a processing unit connected to the bus system (see col. 4, lines 63-65; col. 5, lines 14-29; Fig. 1, Processor 15), wherein the processing unit executes the set of instructions to determine whether the electronic message matches the rule, identify characteristics of the electronic message if a match between the rule and the electronic message is absent, and modify the rule using the characteristics (see col. 10, lines 30-42; Fig. 8, Steps S81-, S820, S825).

Additionally,

The prior art of Elson discloses a data processing system that detects a manipulation of an electronic message in which a rule is associated with the manipulation (see col. 2, lines 10-23; Fig. 1).

In considering claim 12,

Although Elson and Millier et al. show substantial features of the claimed invention, they fails to disclose the bus system being a single bus (i.e. two separate buses are used). Nonetheless, the inclusion of the two buses into one single bus would have been an obvious modification to Elson and Millier et al., as it is well settled that a prima facie case of obvious design choice includes taking separable things and making them integral. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ, 347, 349 (CCPA 1965); see also MPEP § 2144.04. It would have been obvious for a person having ordinary skills in the art to modify Elson and Millier et al. by using a single bus in order to reduce the number of different line carrying information, thus utilizing board space more efficiently.

In considering claim 13,

Millier et al. discloses a data processing system wherein the bus system includes a primary bus and a secondary bus (see Fig. 1, Host Bus 20, Peripheral Bus 40).

In considering claim 14,

Millier et al. discloses a data processing system wherein the processing unit includes a plurality of processors (see Fig. 1, Processors 15<sub>1</sub> – 15<sub>N</sub>).

In considering claim 15,

Millier et al. discloses a data processing system wherein the communications unit is one of a modem and Ethernet adapter (see Fig. 1, Network Interface 80).

Art Unit: 2153

3. Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millier et al. and Elson as applied to claims 1 and 16 above, and further in view of Plank et al. (5,978,566).

In considering claims 5 and 20,

Although Elson and Millier et al. show substantial features of the claimed invention, they fail to disclose a method wherein the folder is a trash folder. However, Plank et al., whose invention is a server based electronic messaging system with user-definable rules with actions specified in triggered rules whose conditions are satisfied, discloses such a trash folder (see col. 1, lines 22-30; Fig. 2, Trash Folder 60). Therefore, given the teachings of Plank et al., it would have been obvious for a person having ordinary skills in the art to modify Elson and Millier et al. by using a trash folder to use generated rules that are based on getting rid of unwanted messages.

#### ***Response to Arguments***

4. Applicant's arguments filed 2/7/03 have been fully considered but they are not persuasive.

5. Applicant(s) argue on page 11, lines 3-12, that none of the references teach the automatic modification of rules for electronic messaging, as opposed to the application/modifying of rules by the user in the prior art. The applicant(s) arguments are not persuasive. There is absolutely no mention of *automatic* modification of rules in any of the claims, thus “modifying the rule using the characteristics to form a modified rule” as applied to Millier et al., and “detecting user input moving an electronic message into a folder...” as applied to Elson et al., cannot be excluded from user-generation of rules.



*Conclusion*

6. This action is made final. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon Johnson whose telephone number is (703) 305-4642. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3230.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Marlon B. Johnson



Dung C. Dinh  
Primary Examiner